

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRENCE P. MEIER,
JAMES S. ZIELINSKI,
JEFFREY M. STUPAR, and
DEEPAK MEHTA

Appeal 2008-0204
Application 10/619,956
Technology Center 1700

Decided: December 6, 2007

Before EDWARD C. KIMLIN, THOMAS A. WALTZ, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

1 Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 9 and 18 through 27, which are the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

I. BACKGROUND

The invention relates to a fitment for mounting and sealing to a flexible bag. Claim 1 is illustrative:

1. An over-molded fitment configured for mounting and sealing to a flexible packaging material comprising:

a flange having first and second sides;

a spout extending upwardly from the first side of the flange; and

a molded sealing media molded over and onto the first side of the flange,

wherein the flange and spout are integral with one another and formed from a single first material, and wherein the sealing media is formed from a second material different from the first material and having a density less than a density of the first material, the sealing media configured for disposition between the first side of the flange and the flexible packaging material when the fitment is mounted and sealed to the flexible packaging material, the sealing media being heat activated to effectively weld the fitment to the flexible packaging material.

The Examiner relies upon the following references as evidence of unpatentability:

De Van	3,696,969	Oct. 10, 1972
Knox	4,851,272	Jul. 25, 1989
Brown	5,203,470	Apr. 20, 1993

ISSUES ON APPEAL

Claims 1, 2, 4, 18, 19, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over De Van in view of Brown. To reject claims 3, 5-9, 20-23, and 25-27, the Examiner adds Knox.

Appellants have not argued any of the claims separately with any reasonable specificity and, therefore, we select one claim, claim 1, to decide the issues on appeal.

Appellants focus their discussion on only one limitation in claim 1 (Br. 4, 6). Appellants contend that the Examiner has incorrectly defined “molded” as it is used in the claim and specification of the present invention and has mischaracterized De Van as teaching a “molded” sealing media (Br. 6).¹

The Examiner contends that the definition of molded is to “give shape to or to form in a mold” and that the adhesive sealing layer of De Van was given a shape when it was placed on the flange of De Van (Ans. 7).

Accordingly, we determine the issue on appeal arising from the contentions of Appellants and the Examiner is: Have Appellants shown that the Examiner reversibly erred in rejecting the claims as unpatentable over the applied references? Specifically, does De Van teach or suggest: “a molded sealing media molded over and onto the first side of the flange” as set forth in claim 1?

Further, we note that the claim is directed to a product. As such, it is the patentability of the product defined by the claim, rather than the process

¹ Appellants do not contest or dispute the Examiner’s factual findings from Brown and Knox (Br. 7, 8, respectively). Therefore, we do not recite these factual findings here but adopt the Examiner’s factual findings and conclusions of law with regard to these references (Ans. 3-6).

for making it, that we must gauge in light of the prior art. *In re Wertheim*, 541 F.2d 257, 271 (CCPA 1976). Thus, an alternative dispositive issue is: Does the prior art applied by the Examiner teach or suggest the *article* that is claimed?

We determine that the Examiner has established a *prima facie* case of obviousness in view of the reference evidence, which *prima facie* case has not been adequately rebutted by Appellants' arguments. Accordingly, we AFFIRM all grounds of rejection presented in this appeal essentially for the reasons stated in the Answer, as well as for those reasons set forth below.

OPINION

A preponderance of the evidence of record supports the following Findings of Facts (FF):

1. De Van describes a spout 24 with a flange 52 integral therewith (Fig 3). De Van describes that a flexible bag 44 is secured onto the flange 52 by an adhesive (col. 4, ll. 1-5).
2. The prior art differs from the disputed claim limitation only in its failure to explicitly state that the adhesive (i.e., sealing media) is molded onto and over the first side of the flange 52².

² "Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the Brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

3. We determine that the limitation in Appellants' claim 1 of "molded sealing media molded onto and over the first side of the flange" is a product-by-process limitation, that is, the limitation defines how the product was made (namely, by a molding process).

4. The resultant end product of the applied references is a spout with an integral flange of a higher density material than the material of a sealing media, a layer of the sealing media (i.e. the adhesive), and a flexible packaging material heat sealed thereto (Ans. 3-4).

5. The plain meaning of the word "molded" includes: 1. to shape in or on a mold; 2. to form into a particular shape; give shape to; and, 3. to fit closely by following the contours of.³

6. The adhesive of De Van would have been extruded out of a container onto the flange (Ans. 7).

7. Extrusion, defined as the act or process of shaping by forcing through a die, or out of an opening in a container, is a molding process.⁴

8. We determine that in context of the overall teachings of De Van that the adhesive was "molded over and onto the first side of the flange" (col. 4, ll. 1-5).

³ "molded." *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. 21 Nov. 2007.

<Dictionary.com <http://dictionary.reference.com/browse/molded>>. We note that no definition of the word "molded" appears in the Specification.

⁴ "extrusion" *The American Heritage Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004.

<http://dictionary.reference.com/browse/extrusion>

"extrusion molding." Definition Copyright ©1989 CRC Press LL; moldings which are made from plastic material by forcing it through a shaped orifice by means of pressure.

<<http://composite.about.com/library/glossary/e/bldef-e2108.htm>>

9. One of ordinary level of skill in the art would be an engineer or scientist who designs fittings for flexible packaging devices as exemplified in the applied references.

Principles of Law

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The legal question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

It has been well established that, for a claim to a product, the patentability of the product defined by the claim, rather than the process for making it must be gauged in light of the prior art. *In re Wertheim*, 541 F.2d at 271, (CCPA 1976); *In re Brown*, 459 F.2d 531, 535 (CCPA 1972). Likewise it has long been held that “[i]f the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317

(Fed. Cir. 2006) (*quoting In re Thorpe*, 777 F.2d 695, [697] (Fed. Cir. 1985)).

Analysis

As noted above, Appellants have only argued that the Examiner failed to properly interpret one limitation in the claim, and thus we will limit our discussion to that limitation in independent claim 1.

Initially, we note that the claim is directed to a product. As such, it is the patentability of the product defined by the claim, rather than the process for making it, that we must gauge in light of the prior art.

Applying this legal principle to the Factual Findings, we determine that the Examiner has established a prima facie case of obviousness that has not been sufficiently rebutted by Appellants.

Claim 1 is directed to an article of manufacture, in particular a fitment configured for mounting and sealing to a flexible packaging material. (The only other independent claim, claim 18, also claims an article of manufacture; that is, a package which includes the fitment sealed to the flexible packaging material.) As such patentability must rest on the structural differences between the fitment of claim 1 compared to those in the prior art. Differences in the process by which the fitment (and the resulting package) are made are relevant only in so far as they further limit the structure of what is claimed. While Appellants and the Examiner have focused on arguing over whether the sealing media of De Van is “molded” onto the flange or not, those arguments do not address a fundamental issue in this case: The issue is whether something in the prior art teaches or suggests *the article* that is claimed. A difference in how the sealing media is applied to the fitment (and/or the packaging material) is immaterial if the

structure and properties of the prior art product and the claimed product are not patentably distinct from each other.

The end product resulting from Appellants' claim 1, when the fitment is attached to a flexible packaging material⁵, is a spout with an integral flange of a higher density material than the material of a sealing media, a layer of sealing media, and the flexible packaging material heat sealed thereto.

The resultant end product of the applied references is likewise a spout with an integral flange of a higher density material than the material of a sealing media, a layer of sealing media (i.e. the adhesive), and a flexible packaging material heat sealed thereto (FF 1, 4).

Thus, we do not see how Appellants' product claim defines over the prior art applied by the Examiner. In a case where patentability rests upon how the claimed product was made, the PTO has no reasonable ability to manufacture and determine whether there is, in fact, a patentable difference between the prior art product and the claimed product. Under the circumstances, it is reasonable to shift the burden to Appellants to show that the claimed product is, in fact, patentably different from the prior art product. *In re Thorpe*, 777 F.2d at 698; *see also In re Best*, 562 F.2d 1252, 1255 (CCPA 1977).

Alternatively, even assuming that "a molded sealing media molded over and onto" the flange results in a structural feature, we find that the Examiner has met the initial burden of presenting a *prima facie* case of obviousness.

⁵ Appellants' claim 18 positively claims the combination of the fitment sealed to the packaging material.

Implicit in our review of the Examiner's obviousness analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation. *See Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 n.3 (Fed. Cir. 1997). During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Although claims are to be interpreted in light of the specification, limitations from the specification are not to be read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Accordingly, we must first construe the disputed term "molded..." as found in the pertinent clause of claim 1 on appeal. According to Appellants' Specification (3: ¶ [0010]), the fitment 10 includes an overmolded sealing media molded onto the first side of the flange. Appellants further teach that "... a layer of material 24 that is over-molded onto the face or side 16 of the flange that is configured for sealing to the packaging P material...The low melt material [24] serves as a tie layer between the HDPE fitment material 10 and the LPDE packaging P material." (Spec. 5: ¶ [0023]). This embodiment is further set out: "That is, subsequent to the injection molding process for forming the fitment, the low melt material 24 [is] molded onto the fitment 10, over the flange face 16." (Spec. 5: ¶ [0024]). "The fitment 10 was then positioned in a subsequent mold ...having a cut out or additional mold cavity conforming to the size and shape of the over-mold portion [24]." (Spec. 7: ¶ [0031]). However, we cannot limit the scope of a disputed term by the embodiments absent an express disclaimer by Appellants of a broader definition. *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Since Appellants present no express disclaimer in their

Specification, we find that “molded over and onto...” as used in claim 1 includes *to form into a particular shape; give shape to; and/or to fit closely by following the contours of* (FF 5).

Using these definitions, we determine that applying the adhesive to the flange as taught by De Van does meet the disputed claim language. The adhesive was “molded over and onto” the flange when it was applied thereto (FF 6-8). Appellants contend that that this is impermissibly reading out that the sealing media be “overmolded” (Br. 7). We disagree for the reasons already discussed and the following reasons. As cited by Appellants (Br. 6), *Phillips* is concerned with the claim language in a *patent*. In this appeal, we are concerned with the claim language during *ex parte* prosecution of a patent application. During *ex parte* prosecution, the Patent & Trademark Office (PTO) determines the scope of the claims by giving the language the broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. Limitations from the specification are not to be read into the claim. We decline to read into the claims any specific “molding” process set out in Appellants’ Specification.

Thus, we agree with the Examiner and determine that the Examiner has established a reasonable belief that De Van suggests a “molded sealing media molded onto and over” the flange 52. We, therefore, conclude that the product of claim 1 is rendered obvious by the applied references.

OTHER ISSUES

In any further prosecution of this case (e.g., if Appellants provide evidence that the structure is different when the process as described in the specification is used to make the sealing tie layer 24), the question of whether a product-by-process limitation regarding a “molded” or “overmolded” sealing media results in a *patentably* distinct structure from one in which an adhesive sealing layer was applied (e.g., De Van) should be explicitly addressed. For example, the teachings of Pierrot cited in related application 11/123,366 should be considered. Pierrot exemplifies that “molding” (as Appellants would interpret the term) an adhesive layer (that is, a tie layer) over and onto a previously molded fitting was known. Thus, the question of whether such a limitation would patentably distinguish a product over the prior art, or whether it was simply a known alternative way for one of ordinary skill in the art to apply an adhesive or tie layer, should be considered.

Keeping in mind that it is the claimed *product* that must be patentably distinguished from the prior art *product*, the Examiner should consider whether, in light of the guidance offered by Pierrot on how to mold an adhesive layer onto a fitting, one of ordinary skill in the art would have combined that familiar treatment to obtain fitments and packages as claimed, with the results being predictable. Further, the problem described by Appellants that their invention solves is bonding two dissimilar materials, namely the fitment and the flexible packaging, to one another (Spec. 2: ¶ [0008]). Brown (applied by the Examiner in this application) also teaches in the packaging art that adhesive layers or tie layers may be present to aid in bonding dissimilar materials to one another (col. 3, ll. 67 to col. 4, ll. 2). See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007) (“The

combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”) and *KSR*, 127 S. Ct. at 1742 (“One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.”).

CONCLUSION

For the foregoing reasons and those stated in the Answer, we determine that the Examiner has established a prima facie case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of Appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of § 103(a). Therefore, we affirm the rejection on appeal based upon § 103(a).

DECISION

The Examiner's decision is **AFFIRMED**.

No time period for taking any subsequent action in connection with this appeal maybe extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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